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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,277	01/13/2000	Ronald A. Katz	249/178 6646-114N7	8176

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EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2643

36

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/483,277

Applicant(s)
Katz

Examiner
Stella Woo

Art Unit
2643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 17, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-61 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 17, 2003 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 47-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-33, 68-79 of U.S. Patent No. 6,335,965. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are broader than the claims in the patent, In re Van Ornum and Stang, 214 USPQ 761. For example, claim 47 of the present application is the same as claim 31 of the patent except that it does not include “generating computer acknowledgement numbers to identify the transaction for the system and individual callers and providing said computer acknowledgement numbers to the individual callers.” Therefore, claim 47 of the present continuation application is broader than claim 31 of the patent.

Claim Rejections - 35 USC § 112

4. Claims 50-61 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

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Independent claim 50 recites “testing at least certain of said data entered by said individual caller to determine if the individual is calling for a first time or to determine if a caller’s status reflects an outdated record.” However, the disclosure fails to provide support for such testing. In the Amendment filed June 18, 2002, Applicant points to page 23, lines 4-11 as providing support. However, this portion of the specification describes the use of a caller’s telephone number from an ANI communication to address the caller’s record and does not recite any “testing...to determine if ...a caller’s status reflects an outdated record.” In applicant’s specification, the caller’s telephone number is received automatically from an ANI communication, not “data entered by said individual caller.”

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barger et al. (USPN 4,071,698, hereinafter “Barger”) in view of Gordon et al. (USPN 4,763,191, hereinafter “Gordon”).

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Barger discloses a method for controlling voice-data communications comprising the steps of:

interfacing certain of a plurality of individual callers with an interface unit (callers with push-button telephones are interfaced with data coupling sets 32; col. 6, lines 35-43; col. 9, lines 20-33);

prompting callers to provide responsive signals representative of identification data (audio program repeater prompts the push-button caller to enter his account number; col. 11, lines 18-23; col. 9, lines 40-42);

receiving, comparing and utilizing (caller enters his account number which is compared with stored data to access a customer's record (col. 2, lines 9-12; col. 6, lines 21-26; col. 8, lines 60+; col. 9, lines 40-44; col. 11, lines 37-47);

transferring at least certain of said callers to an attended terminal (callers whose credit cannot be validated or those determined to be freeloaders or those who key in a specified code requesting operator assistance are automatically connected with an attended terminal 39; col. 9, lines 42-45; col. 11, lines 34-36; col. 9, lines 38-40); and

displaying at said attended terminal (operator's terminal displays all the data for the customer's call including any historical and credit verification data retrieved from memory; col. 5, lines 29-37; col. 6, lines 3-9, 21-29).

Barger differs from the claims in that it does not specify receiving and recording caller number identification signals. However, Gordon teaches the well known use of caller number

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identification signals in a telephone ordering system for identifying callers and recording the caller number identifications signals for compiling the necessary delivery and charging information (col. 2, lines 48-64) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of caller identification signals, as taught by Gordon, within the ordering system of Barger to provide additional identifying data for use in compiling the necessary delivery and charging information.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Any general inquiries should be directed to the Customer Service Office at (703) 306-0377.

April 21, 2003



**STELLA WOO
PRIMARY EXAMINER**